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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 23334 | 7590 | 08/15/2005 | EXAMINER | |
| FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487 | | | NAWAZ, ASAD M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | |

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,872

Applicant(s)

JACKSON, JARED J.

Examiner

Asad M. Nawaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment file on June 7th, 2005. Claims 1-22 were amended and claims 23-30 were withdrawn from consideration due to a restriction requirement. Accordingly claims 1-22 are presented for examination.
2. The claim objection to claim 15 for minor informalities is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically the claimed subject matter pertains the limitations reciting "automatically determined".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-15 and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al, 6,779,040 (Lee hereafter).

As per claims 3 and 13, Lee teaches a system comprising: at least one networked device (104, fig. 1; col. 4, lines 31-32; client computer is a network device);

and a content server for delivering content information to the at least one networked device (102, fig. 1; col. 4, line 42-46;

server provides image content to client devices), the content server including: a first memory for storing at least one of an image delivery parameter and an image presentation parameter associated with a networked device (col. 4, lines 11-15; server stores user device's capabilities and preferences associated with the images stored on the device);

a network interface for communicating with a network link communicatively coupled with the at least one networked device (network interface is an inherent component of a network device);

a controller, communicatively coupled to the first memory and to the network interface (controller is an inherent component of server device);

and a second memory, communicatively coupled to the controller, for storing computer instructions for the controller to control the content server for (also inherent component of server device for processing client requests):

receiving a request for delivery of content information to the at least one networked device, the content information comprising image information (col. 4, lines 18-23; server receives requests from client for image data);

and determining, based on an automatically determined image delivery parameter and an image presentation parameter associated with the at least one networked device, an image format for the image information for delivery of the image information to the at least one networked device and for presentation of the image information at the at least one networked device (col. 4, lines 18-23; upon receiving the image request from a client, the server retrieves the image file and determines the format of the image file according to the client's capabilities or preferences to be delivered to the client);

and providing a response for the request, the response comprising at least a portion of the image information in the image format (col. 4, lines 25-28; server then sends the image response to the client).

Claims 1, 2, 7 and 9 recite similar limitations as claims 3 and 13 and therefore rejected by similar rationale as those claims.

As per claim 11, Lee discloses a method comprising the steps of: storing an automatically determined image delivery parameter and an image presentation parameter associated with a networked device;

receiving a request for delivery of information to the networked device, the information comprising displayable image information (see claims 3 and 13 rejection);

determining available image formats for the displayable image information (col. 2, lines 35-41; server determines from a plurality of different image formats to send to requesting client);

and selecting one of the available image formats, based at least in part on the automatically determined image delivery parameter and an image presentation parameter, for delivery to and presentation at the networked device (col. 2, lines 35-41; after determining from a plurality of image formats, the server selects a best matching version of the image data based on the user's capabilities and sends the image response to the client).

As per claim 4, Lee teaches couple the response to the network interface, the response being destined for reception by the networked device (col. 4, lines 25-28; server sends response to client device).

As per claims 5-6, Lee teaches the second memory includes computer instruction for the controller to control the server system to: receive, along with the request, the at least one of the image delivery parameter and the image presentation parameter associated with the networked device (col. 4, lines 13-18);

and store the at least one of the image delivery parameter and the image presentation parameter in the first memory (col. 4, lines 13-18; server receives user preferences and capabilities along with the request from the user device; server also stores user preferences and capabilities for future reference);

server receives the request from one of the networked device and another requester device (inherent from disclosed invention; server is capable to receive and process plurality of requests from plurality of clients).

As per claims 8, 10, 12, and 14, Lee teaches the step of providing a response for the request, the response comprising at least a portion of the displayable image information in the image format; and sending the file to a network interface, the file being destined for reception by the networked device (col. 4, lines 25-28; server sends image response to user's device).

As per claim 15, Lee teaches the first memory comprises a first database for storing records containing image delivery parameters and image presentation parameters associated with the at least one networked device (col. 4, lines 13-15), and a second database for storing at least one image record (col. 4, lines 11-13).

As per claim 19, Lee teaches image format is selected from a set of image formats including binary bitmap and vector-based graphics (col. 5, lines 27-30; Cartesian volume is the vector-based graphics of JPEG images).

As per claim 20, Lee teaches image format is selected from a set of image formats including JPEG (col. 4, lines 12).

As per claims 21-22, Lee teaches the image delivery parameter corresponds to POTS (114, fig. 1; col. 4, lines 36-38); image presentation parameter corresponds to Desktop Workstation (104, fig. 1; col. 4, lines 32-33).

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Salo et al, 6,563,800 (Salo hereafter).

9. As per claims 16-18, Lee discloses determining, based on at least one of an image delivery parameter and an image presentation parameter associated with the at least one networked device, an image format for the image information and image server serving up the image information in the determined image format (see claims 3 and 13 rejection).

Lee does not explicitly disclose using Application Programming Interface 'API' calls to start these services. However, it is well known and would have been obvious to one of ordinary skill in the art to use API calls between the application program objects and low level interface of the operating system (see Salo disclosure col. 13, lines 30-37).

Response to Arguments

10. Applicant's arguments filed have been fully considered but they are not persuasive. In substance the applicant argues that A) Lee does not teach that the

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image delivery parameter is automatically determined and B) The rationale for combining the references is improper hindsight.

11. In response to A), the limitation state "automatically determined". This term is broad and thus interpreted as such. The limitations as currently presented do not state that automatically determined is equivalent to executing a process without human intervention. The mere fact that the process is executed via a network by computers renders the determination automatically.

In response to B), it is the applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

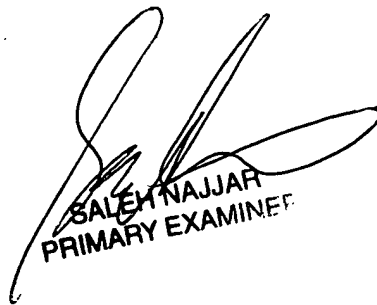
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AMN


SALEH NAJJAR
PRIMARY EXAMINER